UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,244	02/19/1999	STEFAN BREUNIG	022701-803	2643

21839 7590 08/18/2005

BUCHANAN INGERSOLL PC
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER	
MOORE, MARGARET G	
ART UNIT	**PAPER NUMBER**
1712	

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/202,244	BREUNIG ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23, 29 to 33, 37 to 40, 42, 48 and 49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3, 29 to 33, 37 to 40, 42, 48 and 49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 29 to 32, 37 to 40 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ona et al. in view of Bailey.

This rejection is maintained from the previous office action, for reasons of record. As such the rationale for this rejection will not be repeated.

3. Claims 23 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ona et al. in view of Bailey as applied to claims 29 to 32, 37 to 40 and 48 above, and further in view of Togashi et al.

This rejection is maintained from the previous office action, for reasons of record. As such the rationale for this rejection will not be repeated.

4. Claims 37 and 38 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Crivello et al.

This rejection is maintained from the previous office action, for reasons of record. As such the rationale for this rejection will not be repeated.

5. Claim 33 is neither taught nor suggested by the prior art, for reasons of record.

6. Claim 49 is neither taught nor suggested by the prior art. The prior art fails to teach or adequate suggest the totality of this claim, specifically the selection of the particular catalysts in combination with the particular synthons and siloxanes in the preparation of a non-turbid silicone oil of stable viscosity.

7. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The synthon of formula (X) appears incorrect, as it does not contain the C=C

bond which is necessary for hydrosilylation. Compare to the formula on page 11 of the specification.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 23, 29 to 33, 37 to 40, 42, 48 and 49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 16 of U.S. Patent No. 6,545,115.

This rejection is maintained from the previous office action, for reasons of record. As such the rationale for this rejection will not be repeated.

10. Claims 23, 29 to 33, 37 to 40, 42, 48 and 49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to14 of copending Application No. 10/933,542.

This rejection is maintained from the previous office action, for reasons of record. As such the rationale for this rejection will not be repeated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Applicants' arguments have been considered but are not deemed persuasive in overcoming the rejections noted supra.

Regarding the rejection in paragraph 2, supra, applicants submit that the combination does not disclose or suggest all of the features of claim 48, emphasizing the fact that the synthons have to be one of the formula shown and the oil must be devolatilized. This is not persuasive because Bailey teaches devolatilizing the silicones prepared therein (see each working example) and column 5 of Ona teaches ethylene R^7 which corresponds to a synthon having formula (IX). With regard to applicants' position that this combination fails to consider the problem of nonturbid functionalized silicone oil of stable viscosity, note that a prima facie case of obviousness does not require the solution of the same problem or recognition of the same advantages as the applicants' invention.

Applicants' argument regarding the selection of a particular siloxane isn't persuasive since the siloxane (XVI) is clearly within the breadth of Ona. Note that formula (C) therein requires at least two E groups. A skilled artisan would have found the selection of (XVI) to have been obvious over the specific teachings of Ona.

The Examiner does not understand applicants' position that these references are unrelated to one another. Ona *specifically refers* to Bailey in the disclosure.

The Examiner does not rely "heavily" on Example 15 for this rejection; rather, she relies on the entire teachings in Bailey. She does note, however, that Example 15 does not prepare a silane. It prepares a trisiloxane. The only difference between the reactant siloxane in Example 15 and (XVI) is that the claims require greater than 5 Si atoms rather than the 3 shown.

Obviously, Ona would not have referred to the teachings in Bailey as a means of making the siloxanes therein if siloxanes were inoperable. Ona directs one to use the catalyst and method of Bailey, while Ona suggests the selection of a siloxane and synthon as claimed. Clearly the totality of these references suggest the instant process.

Regarding the rejection in paragraph 3, supra, applicants rely on much of the same rationale as they do for the rejection of claim 48, namely that all words in claim 48 are not given proper consideration and that this does not provide proper motivation. The Examiner does not rely on hindsight for motivation to combine these references, but rather she relies on proper motivation that is detailed in the previous office action.

Regarding the rejection in paragraph 4, supra, this too is maintained. Applicants have amended claims 37 and 38 to clearly include product by process language. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. It is the product of the process in claim 48 that is required by these claims. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The reactants are the same and the resulting structures are the same. These oils are storage stable, a property touted by applicants. The Examiner cannot find a difference in the oil prepared by Crivello and the oil prepared by the instant claims and as such this rejection is maintained.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
8/16/05